UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,625	06/18/2001	Jacob Joel Faul	CARDIFF.047A	1239

20995 7590 09/27/2006

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

EXAMINER	
LAFORGIA, CHRISTIAN A	

ART UNIT	PAPER NUMBER
2131	

DATE MAILED: 09/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/883,625	FAUL, JACOB JOEL	
	Examiner	Art Unit	
	Christian La Forgia	2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 July 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *17-19 and 21-31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *17-19 and 21-31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 17 July 2006 has been entered.

2. Claims 17-19 and 21-31 have been presented for examination.

Response to Arguments

3. Applicant's arguments filed 17 July 2006 have been fully considered but they are not persuasive.

4. In response to the Applicant's arguments that none of the cited references disclose wherein a third party receives the transaction certificate, the Examiner disagrees. Column 8, lines 28-44 of Robinson discuss figure 5, which illustrates an example of how a customer can present the receipt back to the merchant for authentication. Specifically at column 8, lines 40-44, Robinson states that although figure 5 illustrates that the customer presents the receipt to the merchant computer, it is generally understood that the receipt may be received by any computer authorized by the merchant system. Therefore, Robinson discloses at column 8, lines 40-44 wherein a third party receives the transaction certificate.

5. The Applicant is reminded that patents are relevant as prior art for all they contain. The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned, and that they are part of the literature of the

art, relevant for all they contain. A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments. See MPEP § 2123; see also *In re Heck*, 699 F 2.d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983); see also *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.).

6. See further rejections that follow.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 18 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,915,022 to Robinson et al., hereinafter Robinson.

9. As per claims 18 and 21, Robinson teaches a method of a third party authenticating a transaction conducted between a first party and a second party, the method comprising:

receiving, by a third party, a transaction certificate with an encrypted code (Figure 1-2 [step 120], column 6, lines 23-48, column 7, lines 33-43, column 8, lines 38-44, i.e. if a customer obtains the merchant's public key the customer could decrypt the transaction receipt, the client presents the digital receipt page to the merchant computer or any computer authorized by the merchant);

retrieving a public key of the first party (column 5, lines 47-50, i.e. if a customer obtains the merchant's public key the customer could decrypt the transaction receipt);

decrypting the encrypted code based on the retrieved public key of the first party to generate decrypted proof elements (column 5, lines 47-50, i.e. if a customer obtains the merchant's public key the customer could decrypt the transaction receipt); and

declaring the conducted transaction including the decrypted proof elements as authenticated if the decrypting is successful (column 2, lines 31-43, column 6, lines 23-67, column 7, lines 1-33).

Claim Rejections - 35 USC § 103

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

11. Claims 17 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson in view of U.S. Patent No. 6,243,480 to Zhao et al., hereinafter Zhao.

12. As per claims 17 and 22, Robinson teaches a method of a third party authenticating a transaction conducted between a first party and a second party, the method comprising:

retrieving, by a third party, a public key of the first party (column 5, lines 47-50, column 7, lines 33-43, column 8, lines 38-44, i.e. if a customer obtains the merchant's public key the customer could decrypt the transaction receipt, the client presents the digital receipt page to the merchant computer or any computer authorized by the merchant);

decrypting the converted encrypted code based on the retrieved public key of the first party to generate decrypted proof elements (column 5, lines 47-50, i.e. if a customer obtains the merchant's public key the customer could decrypt the transaction receipt); and

declaring the conducted transaction including the decrypted proof elements as authenticated by the third party if the decrypting is successful (column 2, lines 31-43, column 6, lines 23-67, column 7, lines 1-33).

13. Robinson does not teach receiving a hard copy transaction certificate with an encrypted code by a third party; and scanning the received transaction certificate to convert the encrypted code into electronic form.

14. Zhao teaches receiving a hard copy of a document with partial authentication information and scanning in the analog reference to convert the encrypted code into an electronic form for verification (column 3, line 57 to column 4, line 14).

15. It would have been obvious to one of ordinary skill in the art to print out a hard copy of the transaction receipt to be scanned in later to verify a transaction, since Zhao states at column 3, lines 41-54 that such a modification would provide a way to authenticate a digital receipt that has been printed out without losing the authentication information.

16. Claims 19 and 23-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson in view of U.S. Patent No. 6,285,991 to Powar, hereinafter Powar.

17. As per claims 19 and 23, Robinson discloses a method of a third party authenticating a transaction conducted between a first party and a second party, the method comprising:

receiving, by the third party, an encrypted transaction certificate (column 5, lines 47-50, column 7, lines 33-43, column 8, lines 38-58, i.e. if a customer obtains the merchant's public key the customer could decrypt the transaction receipt, the client presents the digital receipt page to the merchant computer or any computer authorized by the merchant);

retrieving a public key of the first party (column 5, lines 47-50, i.e. if a customer obtains the merchant's public key the customer could decrypt the transaction receipt);

decrypting the encrypted code based on the retrieved public key of the first party to generate decrypted proof elements (column 5, lines 47-50, i.e. if a customer obtains the merchant's public key the customer could decrypt the transaction receipt); and

declaring the transaction including the decrypted proof elements as authenticated if the decrypting is successful (column 2, lines 31-43, column 6, lines 23-67, column 7, lines 1-33).

18. Robinson does not disclose decrypting the received encrypted transaction certificate based on a private key of the third party so as to generate a transaction certificate with an encrypted code.

19. Powar teaches sending an encrypted statement using a public key system (column 4, lines 55 to column 5, line 17, column 11, lines 1-50). It is known that in public key systems, the public key is available to the public either by the party or at a centralized location. When someone wishes to send an encrypted communication to the party, they retrieve the party's public key, encrypt the communication with the party's public key, transmit the encrypted message to the party at which point the party decrypts the message using the party's private key.

20. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the party's public key to encrypt the transaction certificate for transmission to the party, since Powar states at column 5, lines 6-17 that such a modification would verify the message as being legitimate, since the party is the only one with the private key that could decrypt and read the message.

21. Regarding claims 24 and 28, Robinson does not teach wherein receiving the transaction certificate comprises receiving an e-mail containing the transaction certificate.

22. Powar discloses wherein receiving the transaction certificate comprises receiving an e-mail containing the transaction certificate (column 4, line 55 to column 5, line 38).

23. It would have been obvious to one of ordinary skill in the art at the time the invention was made to e-mail the transaction certificate, since Powar states at column 4, line 32 to column 5, line 38 that it would provide a secure interactive electronic account statement since the user is the only one that has the ability to decrypt the e-mail message to obtain the electronic statement, thereby providing a similar level of privacy and security to that of the United States Postal Service.

24. Regarding claims 25 and 29, Robinson does not disclose wherein receiving the transaction certificate comprises receiving an e-mail containing a URL of the transaction certificate.

25. Powar teaches wherein receiving the transaction certificate comprises receiving an e-mail containing a URL of the transaction certificate (column 4, line 55 to column 5, line 38).

26. It would have been obvious to one of ordinary skill in the art at the time the invention was made to e-mail the URL of the transaction certificate, since Powar states at column 4, line 32 to column 5, line 38 that it would provide a secure interactive electronic account statement since the user is the only one that has the ability to decrypt the e-mail message to obtain the electronic statement, thereby providing a similar level of privacy and security to that of the United States Postal Service.

27. With regards to claims 26 and 30, Powar discloses wherein the e-mail is sent by the first party (column 4, line 55 to column 5, line 38).

28. With regards to claims 27 and 31, Powar teaches wherein the e-mail is sent by the second party (column 4, line 55 to column 5, line 38).

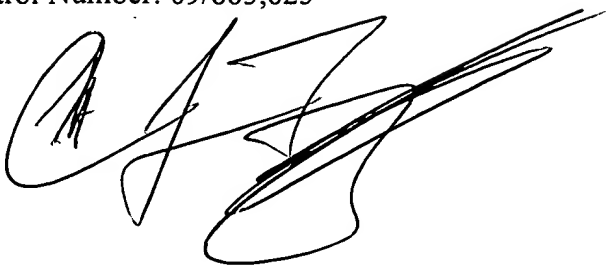
Conclusion

29. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christian La Forgia whose telephone number is (571) 272-3792. The examiner can normally be reached on Monday thru Thursday 7-5.

30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

31. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christian LaForgia



Patent Examiner
Art Unit 2131

clf